

REMARKS

Applicants have received and reviewed the Office Action dated May 12, 2008. Claims 12 - 24 are pending. Claim 22 has been amended. No new claims have been added. Support for currently amended claim 22 can be found throughout the specification as filed.

Election/Restrictions

An election was made during a telephone conversation with Mark Skoog on 5/6/08 with traverse to prosecute invention of group I, claims 12-21. Applicant hereby confirms the provisional election of the invention of group I, claims 12-21. This election is made with traverse.

Indeed, withdrawn claim 22 has been amended to make a formal link with claim 12. As matter of fact, pending claim 22 previously contained a clerical error by defining the hydrogenated compound as being of formula II(E). This is incorrect since the unsaturated compound namely the ene-amide is of formula II(e) as set forth in claim 22. However, the hydrogenated compound is of **formula I** as it results from the wording of claim 12 and from the specification itself.

The correction of the formula for the hydrogenated compound has been made with the present amendment. In addition, the hydrogenated compound of formula I is specified to be as defined in claim 12 wherein R1 and R2 taken together form a di-cyclic ring. In view of this formal link with claim 12 and of such a definition, it is apparent that withdrawn and amended claim 22 has a single generally inventive concept with group I of claim(s) 12-21.

In addition, withdrawn and amended claim 22 now has been defined completely to the hydrogenation reaction, which was not defined in previously pending claim 22. More specifically, it has been recited as follows that "Said method comprising performing a hydrogenation/ isomerization reaction in the presence of a heterogeneous catalyst based on at least one metal selected from Pd, Ir, Rh, or Ni, with an acid derivative of formula (III) $(R_4CO)_mX$ to obtain a hydrogenated compound of formula I, as defined in claim 12, wherein R1 and R2 taken together form a di-cyclic ring."

In view of these amendments in claim 22, it is apparent that claim 22 contains the same essential technical feature which provides the single general inventive concept under PCT Rule 13.1. This special technical feature is not only novel but also unobvious for one skilled in the art

over Johnson (WO99/18065), now cited by the Examiner taken alone or combined with Tinsley (US 3,375,287) as shown here below.

In view of this, Applicants respectfully request that the Examiner consider claims 22-24 as part of Group I and that these claims be examined.

Claim Rejections – 35 USC 103

The Examiner has rejected claims 12-21 under 35 USC 103(a) as being obvious over Johnson (WO99/18065) in view of Tinsley (US 3,375,287).

Johnson discloses a method for synthesis of chiral amines by preparing an enamide from an oxime and subjecting the enamide to catalytic asymmetric hydrogenation. Johnson exemplifies the synthesis of N-(3,4 dihydronaphthalen-1-yl)-acetamide using Fe as a catalyst (page 10, example 5, lines 20-27). It is noted in the Office action that Johnson is deficient in the sense that it does not use Applicants hydrogenation catalyst metal in the recited form, under hydrogen pressure and with the recited mineral salt. Johnson does form an enamide from an oxime through catalytic isomerization but this is performed solely with **iron** as catalyst. Johnson only discloses the use of iron. No other metal catalyst is disclosed. None of the metals of the presently claimed invention (i.e., Pd, Ir, Rh, or Ni) are disclosed or suggested in Johnson in the acetamide synthesis.

Further Johnson teaches away from Applicants' invention by "complexing a transition metal and a chiral bis-phosphine of formula (7) or (8)" (page 5, lines 30-31). Applicants' invention, as shown by example 1 to 5, has an unexpectedly high yield ranging between 57.5% (ex 2d) and 85% (ex 4b). In addition, the chemical purity achieved by the presently claimed method is generally higher than 90% and can reach 98.4% (ex 2a) or 98.95% (ex 1c). These results are in contrast to the yield results reported by Johnson, using the iron catalyst, of only 24% (page 10, line 28).

Tinsley teaches a process that is solely applicable to ethylenically unsaturated compounds which are composed solely of carbon and hydrogen, namely a cycloaliphatic nucleus having up to 16 carbon atoms in said nucleus and at least one migratable ethylenic bond. (col. 1, lines 26-61). Tinsley teaches the equivalency of catalytic reducing metals used for isomerization reaction, which include Ni, Pd, Pt, Rh, Ir, Fe and Ru (column 4, lines 1-2). This process would

not be operable for synthesizing enamides from oximes. In addition, according to the presently claimed invention, the metals listed by Tinsley are not equivalent.

Thus, Johnson does not teach or suggest the presently claimed invention. Tinsley does not cure the deficiencies of Johnson, and the combination of Johnson and Tinsley to not teach or suggest the presently claimed invention.

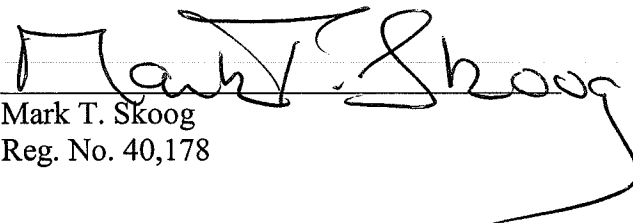
Accordingly, Applicants respectfully submit that the application is condition for allowance and the issuance of a notice of allowance is respectfully solicited. Please charge any additional fees or credit any overpayment to Merchant & Gould P.C., Deposit Account No. 13-2725.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

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MTS:kf


Mark T. Skoog
Reg. No. 40,178